

## REMARKS

The present application includes pending claims 1-28, all of which have been rejected. Reconsideration of the claim rejections is requested.

On January 4, 2006, the Examiner issued a Final Office Action with respect to the application. On February 15, 2006, the Applicants filed a Notice of Appeal and Pre-Appeal Brief Request For Review. A reviewing panel responded by reopening prosecution. *See* March 13, 2006 Notice of Panel Decision (reopening prosecution). This was not the first time prosecution was reopened in response to a Notice of Appeal and Pre-Appeal Brief Request For Review. *See* August 3, 2005 Notice of Appeal and Pre-Appeal Brief Request For Review; *see also* September 14, 2005 Notice of Panel Decision (reopening prosecution).

Despite the two previous final rejections and Panel Decisions reopening prosecution, the March 13, 2006 Office Action relied on previously asserted grounds for rejection and on a previously cited reference, U.S. Patent No. 6,114,623 to Bonilla et al. ("Bonilla").

Bonilla was cited two years prior in a March 17, 2004 Office Action rejecting all of claims 1-28. *See* March 17, 2004 Office Action. Bonilla was withdrawn, however, after the Applicants amended certain claims in a June 14, 2004 response to that office action and an October 6, 2004 response to a subsequent August 6, 2004 Office Action. *See* November 2, 2004 Office Action (not citing Bonilla). Bonilla then resurfaced in the March 13, 2006 Office Action after two years, two final rejections, and two re-openings of prosecution.

In a response to the March 13, 2006 Office Action, Applicants explained in depth why the pending claims are patentable over Bonilla and the other reference relied upon, U.S. Patent No. 6,417,446 to Whitehead ("Whitehead"). *See generally* April 10, 2006 Response. The July 17, 2006 Final Office Action, however, maintains the exact same rejections and bases for rejections. *See generally* July 17, 2006 Final Office Action. Notably, all of the rejections rely in

whole or in part on Bonilla, the very reference which was withdrawn over two years ago after Applicants amended their claims.

The Applicants respectfully traverse the rejections at least for reasons previously discussed during prosecution of the present application, and the following:

**I. Rejection Under 35 U.S.C. § 102(e)**

Claims 1-2, 4-7, 9-11, 13-14, 18, 20-22, and 24-26 stand rejected under 35 U.S.C. §102(e) as being unpatentable by Bonilla.

Independent claims 1, 6, 11, 14, 18, 21, and 26 specify that each simplex power receptacle includes a respective housing, a feature that is neither disclosed nor suggested by Bonilla. Rather, Bonilla discloses a poke though fitting wherein a single housing (receptacle 34) presents four power outlets 18. The power outlets 18 of Bonilla clearly are not “separately formed simplex power receptacles” because they all share a common housing and also share common bus bar elements. *See* Bonilla at Figures 1 and 4. The Final Office Action states:

The examiner interpreted the Bonilla et al as follow:

The examiner believed that Bonilla et al clearly disclosed that four separately formed simplex power receptacle 18 supported by the insert, each of said power receptacles having a separate housing (see fig 1, column 4 lines 1-10), and it is noted that with respect to Simplex power receptacle, the Applicant does not describe any criticality of said power receptacle.

July 17, 2006 Final Office Action at page 20. First, the Applicants respectfully point out that, contrary to the interpretation above, **Bonilla explicitly states that a single receptacle houses all four power receptacles.** *See* Bonilla at column 4, lines 4-5 (“Receptacle 34 houses two pairs of electrical outlets 18.”). Second, there is no requirement to describe a “criticality” of a claim term, and the Office Action cites no law in support thereof. Thus, at least for these reasons,

Bonilla does not anticipate claims 1-2, 4-7, 9-11, 13-14, 18, 20-22, and 24-26.

## **II. Rejection Under 35 U.S.C. § 103 (a)**

Claims 1-28 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Whitehead in view of Bonilla.

### **A. The Combination Of Whitehead And Bonilla Does Not Disclose Or Suggest Four Simplex Power Receptacles Each Having Its Own Respective Housing As Specified By Claims 1-28**

Independent claims 1, 6, 11, 14, 16, 18, 21, 26, and 27 specify four simplex power receptacles, each having its own respective housing, a feature that is neither disclosed nor suggested by the proposed combination of Whitehead and Bonilla.

Whitehead discloses a poke-through fitting having two duplex power receptacles. That is, Whitehead discloses a poke-through fitting wherein two housings (98 and 99) present a total of four power outlets. *See* Whitehead at Fig. 5. The Office Action even concedes that Whitehead “fails to disclose each of said power receptacles having a separate housing.” *See* Office Action at 7.

But, the Office Action asserts that Bonilla “teach[es] the use of a simplex receptacle 18 having a separate housing (see fig 1, column 1 lines 58-65 and column 2 lines 59-67).” *See* Office Action at 7. Figure 1 of Bonilla, however, illustrates four power outlets 18 comprising a single housing (*i.e.*, receptacle 34). *See* Bonilla at Figure 1; *see also* Bonilla at column 4, lines 4-5 (“Receptacle 34 houses two pairs of electrical outlets 18.”). Also, nothing from the portions of the specification, which are cited by the Office Action, discloses “a simplex receptacle 18 having a separate housing”:

The foregoing objects are further obtained by providing a fitting comprising: an electrical receptacle; a first pair of electrical outlets

coupled to the electrical receptacle and electrically connected to a first electrical source by a first set of electrical wires; a second pair of electrical outlets coupled to the electrical receptacle and electrically connected to a second electrical source by a second set of electrical wires; and at least one voice/data outlet coupled to the electrical receptacle.

\* \* \*

FIGS. 1-5 illustrate a fitting 10 in accordance with a first embodiment of the present invention. Fitting 10 is a fire-rated, poke-through floor fitting. When assembled, fitting 10 is preferably intended to be inserted into a bore 12 formed in a concrete floor 14. The fitting 10 then provides easy access to electrical outlets 18 and voice/data jacks 20 at a position on floor 14 that is typically spaced from any walls. Fitting 10 provides easy access to a plurality of electrical outlets 18 and voice/data outlets or jacks 20.

Bonilla at column 1, lines 58-65 and column 2, lines 59-67.

The power outlets of Bonilla and Whitehead clearly are not “separately formed simplex power receptacles” because none of them has its own respective housing. Accordingly, the proposed combination of Whitehead and Bonilla fails to disclose four simplex receptacles each having its own respective housing.

Thus, for at least this reason, the Applicants respectfully submit that the claims of the present application should be in condition for allowance.

**B. The Combination Of Whitehead And Bonilla Does Not Disclose Or Suggest Four Communication/Data Jacks Being Arranged In A Longitudinal Row As Specified By Claims 16-17 and 27-28**

Independent claims 16 and 27 specify four communication/data jacks being arranged in a longitudinal row, a feature that is neither disclosed nor suggested by the proposed combination of Whitehead and Bonilla.

The Office Action states that “Whitehead discloses: ... four communication/data jacks

126, 127, 162 ... the communication/data jacks being arranged in a longitudinal row (see fig 6).” *See* Office Action at 12-13. Whitehead does disclose four data jacks, but they are clearly not arranged in a longitudinal row. *See* Whitehead at Figure 6. Rather, the third and fourth data jacks are positioned to the side of the first and second data jacks along “a wing 162.” *See* Whitehead at column 8, lines 7-11. Accordingly, the proposed combination of Whitehead and Bonilla fails to disclose “four communication/data jacks within the fitting, the communication/data jacks being arranged in a longitudinal row,” as recited in claims 16 and 27.

Thus, for at least this reason, the Applicants respectfully submit that the claims of the present application should be in condition for allowance.

**C. There Is No Motivation To Combine Whitehead With Bonilla**

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure (MPEP) states the following:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art.

MPEP § 2142. Additionally, if a *prima facie* case of obviousness is not established, the Applicants are under no obligation to submit evidence of nonobviousness.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

*See id.*

**1. Whitehead and Bonilla Cannot Be Combined Without Running Afoul Of Their Stated Purposes**

Whitehead discloses a “poke-through device for installation in a hole extending through a concrete floor structure of a building.” *See* Whitehead at Abstract. Whitehead further discusses that the size of a poke-through device is limited by the floor opening into which it is positioned.

[P]roblems still remain with the use of poke-through devices. Once such problem involves the **limited number of electrical interfaces** provided by the prior art devices. It will be recognized that the size of the hole which may be drilled through a concrete floor is limited by the structural characteristics of the floor. Typically, **building codes allow the drilling of a hole having a diameter between about two and four inches, which thus limits the maximum size of the poke-through device.** However, even utilizing the mentioned four inch diameter hole, prior art devices only provide a **limited number of electrical interfaces.** For example, a single prior art poke-through device typically provides only a two-plug arrangement.

Whitehead at column 1, lines 50-62 (emphasis added). *See also id.* at column 4, line 65 to column 5, line 3 (“Inasmuch as floor structure 14 is typically a structural, load bearing member of the building, the maximum size of the interfloor is **limited by building code requirements.** In particular, interfloor holes, typically range in diameter from two to four inches.”).

Whitehead clearly recognizes the difficulties of trying to maximize electrical applications on the limited area of a poke-through, the size of which is dictated by a corresponding floor opening. As such, Whitehead discloses specific designs intended to maximize such capabilities. In particular, Whitehead discloses the following:

The device provides a four-plug arrangement, together with two data connection jacks, all located in a concealed manner. The device alternatively provides a two-plug arrangement, together with four data connection jacks. An additional alternative embodiment provides an arrangement having six data connection jacks.

Whitehead at Abstract. Notably, Whitehead only discloses those three embodiments. In short, Whitehead's embodiments attempt to maximize use of the limited space on a poke-through by the three disclosed embodiments. Introducing additional materials into the limited space of Whitehead's poke-through fittings, however, would increase their sizes, thereby precluding them from being used in constrained spaces (*i.e.*, in holes that "range in diameter from two to four inches", which are mandated by building codes, as noted above).

To maximize the space on a poke-through surface, Whitehead discloses specific embodiments that allow for three different arrangements, as noted above in the Abstract of Whitehead. In particular, Whitehead discloses specific wedge-shaped electrical duplexes, or, alternatively, a bow-tie configuration.

As shown, the receptacles are preferably formed as separate wedge-shaped units, each including two electrical outlets. The electrical outlets, *i.e.*, outlets 114, are configured for receipt of conventional 110 voltage electrical plugs. Of course, the outlets may be configured for receipt of various other electrical plugs. Alternatively, the receptacle may be formed as a single "bow-tie" shaped four-plug unit (receptacle 98').

*Id.* at column 6, line 63 to column 7, line 3. In an effort to maximize the space on the poke-through, Whitehead only discloses the use of the specific wedge-shaped duplex receptacles, or the bow-tie quad receptacle. Adding or substituting other receptacles would add size to Whitehead's poke-through, and therefore make it unusable for its intended purpose. With that in mind, the Applicants now turn to Bonilla.

The poke-through fitting of Bonilla is "**for use in a three-inch diameter** bore and having four electrical outlets and four voice/data jacks while maintaining a low profile." *See* Bonilla at column 1, lines 6-10. To maximize the space in the poke-through fitting, a single housing is

“efficiently formed” to comprise all four power outlets in the space of less than three inches:

Receptacle 34 houses two pairs of electrical outlets 18. ...  
Receptacle 34 is efficiently formed to fit within a three inch  
diameter opening. That is, receptacle 34 has a width in any  
direction of plane 211 of less than three inches.

*See* Bonilla at column 4, lines 4-5 and lines 9-12. Thus, Bonilla “optimize[s] the arrangement of elements to produce a compact fitting with a relatively high number of electrical and voice/data connections while maintaining a low profile, which is generally flat and close to the floor.” *See* Bonilla at column 7, lines 49-53.

As set forth above, both Bonilla and Whitehead teach specific arrangements of power receptacles (outlets) and data/communication jacks, arrangements that have already consumed their allotted spaces. They do not – even when considered together – teach how four simplex power receptacles (outlets) each having its own respective housing could be arranged within the limited spaces that Bonilla and Whitehead describe. Moreover, Bonilla teaches away from each power receptacle having its own respective housing. In that regard, Bonilla teaches all four power outlets in a single “efficiently formed” housing that is “less than three inches” in diameter. *See* Bonilla at column 4, lines 4-5 and lines 9-12.

The July 17, 2006 Final Office Action wholly fails to address the size limitations of the prior art and the resulting unfeasibility of combining of their components, which is discussed above and in Applicants’ previous April 10, 2006 response. Thus, for at least these reasons, the Applicants respectfully submit that the claims of the present application should be in condition for allowance.

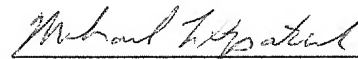
### **III. Conclusion**



In view of the above, claims 1-28 are believed to be in condition for allowance. The Examiner is invited to telephone the Applicants' undersigned attorney at (312) 775-8000 if any unresolved matters remain. Please charge any fees due in connection with this submission to Deposit Account No. 13-0017.

Respectfully submitted,

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